



Docket No.: SON-3162
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toshihiko Shirasagi, et al.

Application No.: 10/579,211

Confirmation No.: 6592

Filed: May 12, 2006

Art Unit: 1795

For: MANUFACTURING METHOD OF MASTER
DISC FOR OPTICAL DISC, AND MASTER
DISC FOR OPTICAL DISC

Examiner: A. L. Verderame

PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW FINAL OFFICE ACTION

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby petitions for the withdrawal of the Final Office Action dated November 4, 2009.

U.S. Patent practice and procedures pursuant to M.P.E.P. §706.07(c) provide the following:

Any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

This is a petitionable issue because Applicant seeks review of the prematurity of the final rejection within the Final Office Action of November 4, 2009.

ARGUMENT

The “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement” (emphasis added). M.P.E.P. §706.07(a).

The finality of the rejection of claims 1 and 7 made within the Final Office Action of November 4, 2009 is a new ground of rejection and premature at least for the following reasons.

I. Non-final Office Action dated September 3, 2008

Paragraph 2 of the non-final Office Action dated September 3, 2008 has failed to include a rejection of either original claim 3 or original claim 9.

II. Amendment in Response to Non-Final Office Action filed on December 3, 2008

The Amendment in Response to Non-Final Office Action filed on December 3, 2008 wholly incorporates the features of original claim 3 into claim 1 to form amended claim 1.

No other amendment to claim 1 is found within the Amendment in Response to Non-Final Office Action.

As a result of this amendment, originally-filed claim 3 is now finally rejected claim 1.

Moreover, the Amendment in Response to Non-Final Office Action filed on December 3, 2008 wholly incorporates the features of original claim 9 into claim 7 to form amended claim 7.

No other amendment to claim 7 is found within the Amendment in Response to Non-Final Office Action.

As a result of this amendment, originally-filed claim 9 is now finally rejected claim 7.

III.Final Office Action dated February 18, 2009

Recall, the non-final Office Action dated September 3, 2008 has failed to include a rejection of either original claim 3 or original claim 9.

Further recall, claim 1 is originally-filed claim 3 and claim 7 is originally-filed claim 9.

Nevertheless, paragraph 2 of the Final Office Action dated February 18, 2009 cites International Application Publication No. WO 2004/034391 (Kouchiyama'391) in the new rejection of claims 1 and 7.

As a consequence, the new rejection of claims 1 and 7 made within the Final Office Action of February 18, 2009 is a new ground of rejection that was neither necessitated by applicant's amendment of claims 1 or 7 within the Amendment in Response to Non-Final Office Action filed on September 3, 2008 nor based on information submitted in an information disclosure statement.

Accordingly, the finality of the rejection of claims 1 and 7 made within the Final Office Action of February 18, 2009 is premature at least for this reason.

IV. Amendment After Final Office Action Under 37 C.F.R. 1.116 filed on March 31, 2009

A paper titled “Amendment After Final Office Action” was filed on March 31, 2009.

No amendment to claim 1 is present within the paper of March 31, 2009. Thus, the presence of originally-filed claim 3 continues to be in the form of claim 1.

No amendment to claim 7 is present within the paper of March 31, 2009. Thus, the presence of originally-filed claim 9 continues to be in the form of claim 7.

No other amendment is present within the paper of March 31, 2009.

V. Pre-Appeal Brief Request for Review filed on June 18, 2009

In full and timely response to the Final Office Action of February 18, 2009, a Pre-Appeal Brief Request for Review was filed on June 18, 2009.

This Request challenges the propriety of the Final Office Action of February 18, 2009.

VI. Notice of Panel Decision dated October 30, 2009

As a reply to the Pre-Appeal Brief Request for Review of June 18, 2009, the Notice of Panel Decision from Pre-Appeal Brief Review dated October 30, 2009 advises that the rejection of February 18, 2009 has been withdrawn and prosecution reopened.

Appropriately, the Panel has decided the finality of the rejection of claims 1 and 7 made within the Final Office Action of February 18, 2009 to be premature and withdrawn.

VII. The Final Office Action of November 4, 2009

The Final Office Action of November 4, 2009 is the *first* Office Action following the Decision on Appeal.

The Final Office Action of November 4, 2009 *reopened prosecution* of the application following a Decision on Appeal of October 30, 2009.

A. Paragraph 2 of the Final Office Action of November 4, 2009 includes a *new ground of rejection of claims 1 and 7*

Paragraph 2 of the prior Final Office Action dated February 18, 2009 indicates alternative rejections of claims 1, 4-7 and 10 under 35 U.S.C. §103.

These *alternative* rejections within the prior Final Office Action of February 18, 2009 include:

1. A rejection based upon Japanese Application Publication No. 2003-315998 (Kouchiyama'988) or
2. A rejection based upon International Application Publication No. WO 2004/034391 (Kouchiyama'391) in view of U.S. Patent No. 4,786,538 (Saito), U.S. Patent No. 4,916,048 (Yamada), and Japanese Application Publication No. 2001-344826 (Lee).

Now, however, paragraph 2 of the *latest* Final Office Action dated November 4, 2009 appears to have *substituted* Kouchiyama'988 for Kouchiyama'391.

In particular, that Office Action asserts a rejection of at least claim 1 (*original claim 3*) and claim 7 (*original claim 9*) under 35 U.S.C. 103(a) as being unpatentable over Kouchiyama et al. JP-2003-315988 (*instead of Kouchiyama '391*) in view of Saito et al. U.S. Patent No. 4,786,538, Yamada et al. 4,916,048, and Lee et al. JP-2001-344826.

Accordingly, the finality of the rejection of claims 1 and 7 made within the Final Office Action of November 4, 2009 is premature as a result of this substitution.

B. The Panel Decision of October 30, 2009 has earlier reversed the rejection alleged to be existent within the Final Office Action of November 4, 2009

Page 5 of the Final Office Action of November 4, 2009 asserts:

As a further note the examiner points out that the rejection of claims 1-10 in the non-final office action and the rejection of claims 1, 4-7 and 10 in the final office action rejects these claims over independent references Kouchiyama '391 or in the alternative Kouchiyama '988 in view of dependent references Yamada, Saito, and Lee. The fact that the independent references are cited in the alternative is shown by the use of the word "or" in the statement of rejection and based on the recitation that it would be obvious to modify both of these methods in the same way as indicated in the "statement of obviousness".

In response, there is no concession as to the veracity of this assertion.

But even if this assertion is indeed correct, this rejection within the Final Office Action of November 4, 2009 would have been reviewed and reversed by a Panel, with this rejection being withdrawn by the Notice of Panel Decision from Pre-Appeal Brief Review dated October 30, 2009.

Accordingly, the finality of the rejection of claims 1 and 7 made within the Final Office Action of November 4, 2009 is premature as a result of this reversal.

C. No amendment to claim 1 (original claim 3) is found within the Amendment After Final Office Action of March 31, 2009

Recall, claim 3 has been placed into claim 1 by the Amendment of December 3, 2008 to become amended claim 1.

The Amendment After Final Office Action of March 31, 2009 is absent any amendment to claim 1 (original claim 3).

As a consequence, claim 1 finally rejected in the Final Office Action of November 4, 2009 is merely originally-filed claim 3.

The originally-filed claim 3 (*now claim 1*) has continuously and erroneously remained finally rejected in each and every Office Action subsequent to the non-final Office Action of September 3, 2008 despite the absence of any rejection of those originally-claimed features in an Office Action prior to, or within, the non-final Office Action of September 3, 2008.

Hence, the finality of the rejection of claim 1 made within the Final Office Action of November 4, 2009 is premature at least for this absence of any rejection.

D. No amendment to claim 7 (original claim 9) is found within the Amendment After Final Office Action of March 31, 2009

Recall, claim 9 has been placed into claim 7 by the Amendment of December 3, 2008 to become amended claim 7.

The Amendment After Final Office Action of March 31, 2009 is absent any amendment to claim 7 (original claim 9).

As a consequence, claim 7 finally rejected in the Final Office Action of November 4, 2009 is merely originally-filed claim 9.

The originally-filed claim 9 (*now claim 7*) has continuously and erroneously remained finally rejected in each and every Office Action subsequent to the non-final Office Action of September 3, 2008 despite the absence of any rejection of those originally-claimed features in an Office Action prior to, or within, the non-final Office Action of September 3, 2008.

Hence, the finality of the rejection of claim 7 made within the Final Office Action of November 4, 2009 is premature at least for this absence of any rejection.

E. No intervening Non-Final Office Action following the non-final Office Action dated September 3, 2008 is present within the file history for the instant application

Pages 4-5 of the Final Office Action of November 4, 2009 conclude that:

Applicant claims that the rejection at paragraph 2 of the non-final office action mailed on September 3, 2008 has failed to include a rejection of either original claim 3 or 7. This is correct and the examiner stated that this rejection was withdrawn in the final office action due to applicant's inclusion of the limitations of claims 3 and 7 into the independent claims.

However, no intervening Non-Final Office Action subsequent to the non-final Office Action of September 3, 2008 is present within the file history for the instant application.

Accordingly, the finality of the rejection of claims 1 and 7 made within the Final Office Action of November 4, 2009 is *premature* in the absence of an intervening Non-Final Office Action.

VIII. A Final Office Action and a Non-Final Office Action is not one in the same

U.S. Patent practice and procedures provide that the Examiner *is permitted to refuse entry* of an amendment to the claims filed in response to a Final Office Action unless that amendment *merely* cancels claims, adopts the Examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review, or unless the Final Office Action is withdrawn in favor of a new Office Action or a Notice of Allowability. M.P.E.P. §714.13(II).

As a consequence, the absence of any Non-Final Office Action following the non-final Office Action dated September 3, 2008 even when the Final Office Action of November 4, 2009 alleges a withdrawal of a rejection of claims 3 and 9 may quite possibly have prejudiced the prosecution of the present application.

CONCLUSION

The finality of the rejection of claim 1 (originally-filed claim 3) and claim 7 (originally-filed claim 9) made within the Final Office Action of November 4, 2009 is *premature* at least for the reasons provided hereinabove.

RELIEF

"If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection." M.P.E.P. §706.07(d).

Accordingly, Applicant hereby petitions the Commissioner under 37 C.F.R. §1.181 to direct the examiner to withdraw the finality of the Office Action mailed in the above-identified application on November 4, 2009.

FEES

No fee is believed required to support this petition. See 37 C.F.R. §1.181.

However, if any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: December 14, 2009

Respectfully submitted,
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